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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,408

07/15/2005

Yasuaki Ito

10577.0004-00000

8596

22852 7590 05/13/2011
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EXAMINER

HOWARD, ZACHARY C

ART UNIT

PAPER NUMBER

1646

MAIL DATE

DELIVERY MODE

05/13/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/542,408	Applicant(s) ITO ET AL.	
	Examiner ZACHARY HOWARD	Art Unit 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 April 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1,3,14 and 78-80.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Bridget E Bunner/
 Primary Examiner, Art Unit 1647

Continuation of 3. NOTE: The proposed amendments filed after a final rejection, but prior to the date of filing a brief, will not be entered because they raise new issues that would require further consideration and/or search.

In the proposed amendment to claim 1, the method would be amended to limit the cell-stimulating activity of step (ii) to one previously recited in dependent claim 14 (which would be canceled), with the exception of intracellular Ca^{2+} level increasing activity. The rejection of claim 1 under 35 USC 102(b) as being anticipated by Sidhu et al (2000) set forth previously at pg 8-12 of the 1/28/11 Office Action was based on a cell-stimulating activity that is an intracellular Ca^{2+} level increasing activity. Thus, the proposed amendment to claim 1 would require new search and consideration of the prior art to determine whether there is any prior art that anticipates or renders obvious the method of claim 1 as directed to a cell-stimulating activity that is one of those recited in the proposed amendments to claim 1 (intracellular cAMP production suppressing activity, MAP kinase phosphorylation or activation, ACTH secretion suppressing activity, glycerol production suppressing activity and lipolysis suppressing activity).

In the proposed amendment to claim 3, the method would be amended to limit the fatty acid of step (i) to one that is labeled and selected from palmitoleic acid, linoleic acid, γ -linolenic acid, arachidonic acid, and docosahexaenoic acid. These limitations were not previously recited in the claims. The rejection of claim 1 under 35 USC 102(b) as being anticipated by Sidhu et al (2000) set forth previously at pg 8-12 of the 1/28/11 Office Action was based on a fatty acid that is dodecanoic acid. Thus, the proposed amendment to claim 1 would require new search and consideration of the prior art to determine whether there is any prior art that anticipates or renders obvious the method of claim 1 as directed to a fatty acid that is labeled and selected from palmitoleic acid, linoleic acid, γ -linolenic acid, arachidonic acid and docosahexanoic acid. It is noted that Sidhu et al teach that the response of STC-1 cells to fatty acids is mediated by a signal transduction pathway which is sensitive to fatty acids of chain lengths greater than 9 carbon atoms (pg 175), and each of the fatty acids recited in proposed claim 3 has a chain length greater than 9 carbon atoms.